

REMARKS

Reconsideration and removal of the grounds for rejection are respectfully requested.

Claims 1-15 were in the application, claims 1-15 have been cancelled and new claims 16-32 substituted therefore.

The applicant respectfully traverses the Examiners' determination that the oath was defective. The oath clearly states the applicant acknowledges the duty to disclose material information "as defined by Title 37, Code of Federal Regulations 1.56". The objection to the oath should be withdrawn.

The Examiner objected to the abstract, and a replacement abstract is being submitted herewith. The corrections made are shown in the appended marked up copy of the original abstract. Consequently, the objection is now moot.

Claims 8 and 9 were objected to as being in improper form. The cancellation of these claims renders moot the objection.

Claims 1-15 were rejected as being indefinite for multiple deficiencies. While rendered moot by their cancellation, each of the issues raised by the Examiner has been considered and addressed in the preparation and presentation of new claims 16-32. The claims were revised for clarity, and to place them in proper U.S. claim format, and it is believed that this rejection has been rendered moot. In the event that minor corrections are still required to correct deficiencies under 35 USC 112, second paragraph, the Examiner is hereby authorized to make those corrections by Examiners' Amendment to expedite prosecution.

Claims 1-15 were rejected as being obvious over Ramspeck, U.S. Patent no. 3,547,003.

To establish a prima facie case of obviousness, there should be some teaching, suggestion or motivation in the prior art to make the specific claimed combination that was made by the applicant. In re Raynes, 7 F.3d 1037, 1039, 28 U.S.P.Q.2D (BNA) 1630, 1631 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D (BNA)

1443, 1445 (Fed. Cir. 1992). However, the search for a teaching or suggestion should not be rigid, and a more flexible approach to a determination of obviousness should be used so as to avoid conflict with common sense. KSR International Co. v. Teleflex Inc. et al, 2007 U.S. Lexis 4745 U.S. Supreme Court, April 30, 2007. The Supreme Court reaffirmed that obviousness can not be established by a hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18 U.S.P.Q.2D (BNA) 1885, 1888 (Fed. Cir. 1991). It is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

The applicants' invention provides single trigger control, allowing a user to switch from a single hit, to automatic, using the same trigger. This switching mechanism is provided using the combination of four valve means identified in claim 1, integrated so as to be responsive to operation of a single trigger pull, with an intermediate position switching the mode. Thus, a user does not have to stop and operate a separate switch to switch between modes. In particular, there is positive feedback to the user when activating the automatic mode, when the trigger within the hollowed portion engages the fourth valve means.

The Examiner did not find four valve means within the reference, and attempted to ignore the missing valve by asserting that Ramspeck has an integral valve versus a valve in two pieces, but this is not an accurate description of the applicants' invention. Rather, four independent, distinct and separate valve means are required to practice the applicants' invention. The Examiner did not identify which of applicants valve means are allegedly integrated together, and a review of the drawings accompanying the application, show the four valve means as separately disposed, so they operate independent of each other, so there is no support for the argument that any of these could be considered two parts of the same valve.

Ramspeck has only three valves. Ramspeck fails to teach or suggest to one skilled in the art the use of a fourth valve. To the contrary, one skilled in the art would be led away from the applicants' invention, believing that the three valve system is

adequate, and find no motivation to add another valve which would increase the complexity of the device. Absent such a teaching, suggestion or motivation, one skilled in the art would not find the claimed invention obvious over Ramspeck, and the rejection of claims 1-15 should be withdrawn

Based on the above amendments and remarks, favorable consideration and allowance of the application are respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

/WJS _____

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MARKED UP COPY OF THE ABSTRACT

A pneumatic fixing machine ~~comprises~~ has a piston ~~mean~~ (30) sliding ~~into~~ within a cylinder (33); a first valve means (5) ~~mobile~~ movable between two ~~extreme~~ opening (E) and closing (D) positions, in correspondence of which the first valve connects an ~~they connect in flow communication~~ a inlet portion (33a) of ~~said the~~ cylinder (33) ~~respectively~~ with either a feeding of pressurized fluid ~~and or~~ with an external outlet, ~~respectively~~. ; A second valve means (2) ~~which can be is~~ operated by ~~means of~~ a trigger ~~mean~~ (7), the second valve being movable and mobile at least between an occlusion position (M) and a passage position (L) to either connect in flow connection, through at least a first duct (9) ~~and~~; a base portion (5a) of the first valve means (5) ~~respectively~~ with the feeding of pressurized fluid ~~in pressure and or~~ with an external outlet. The machine (1) ~~comprises:~~ has a third valve means (3) ~~mobile~~ movable between a position of obstruction (N) and a crossing position (Q), ~~respectively~~ to either cut off or to open a flow connection between the duct (9) and the first valve means (5), ~~respectively, and a~~; fourth valve means (4) which ~~can be~~ operated by ~~means of~~ the trigger ~~mean~~ (7), the fourth valve being movable and mobile between a block position (S) and a transit position (T), ~~in which respectively they to either~~ obstruct flow or ~~make allow~~ free a-flow connection between the cylinder (33) and the third valve means (3).